

Serial No.: 09/189,112

Attorney Docket No. 98P7917US

REMARKS

Claims 1-20 are pending. Claims 1, 5, 14, and 16 have been amended to correct alleged informalities or overcome Section 112 rejections.

Claims 1 and 14 were objected to for alleged informalities. Claim 1 has been amended in accordance with the suggestion in the Official Action to provide parenthetical acronyms. Claim 14 has been amended to correct a typo. As such, Applicants respectfully submit that the basis for the objection is obviated.

Claims 5, 8-12, and 16 were rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicants regard as the invention. In particular, in claim 5, the term "said one or more telephony devices coupled to said server" was indicated to lack antecedent basis. Claim 5 has been amended to recite "said one or more second telephony devices coupled to said server." In claims 8 and 11, the phrase "said call processed by said PBX" was indicated to lack antecedent basis. Applicants respectfully submit that claim 6, from which both claims 8 and 11 depend, recites "accessing a database at said ToL server to determine if bandwidth is available on said LAN for a call processed by said PBX" and thus the phrase "said call" has appropriate antecedent basis. In claim 16, the term "a Tol call" was indicated to be unclear. Claim 16 has been amended to recite "at least one of said ToL phone calls." Applicants respectfully submit that these amendments and/or arguments render moot the rejection for these claims and dependent claims 9, 10, and 12. As such, the Examiner is respectfully requested to reconsider and withdraw the rejections of the claims.

Claims 1-5, 14, 17, and 19-20 have been rejected under 35 U.S.C. § 103 as being unpatentable over Swartz et al., U.S. Patent No. 6,330,244 B1 ("Swartz") in view of Naudus, U.S. Patent No. 6,259,691 ("Naudus"). Applicants respectfully submit that the claimed invention is not taught, suggested, or implied by Swartz or Naudus, either singly or in combination. As described in the Specification, and in response to previous Official Actions, one aspect of the invention relates to a

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combined ToL-PBX system which can support *both* ToL telephony and TFA or "Glass Phone" telephony. ToL telephony that uses local area networks may be based on the H.323 Recommendation and employs a server or gatekeeper that may gradually replace PBXs. Telephony feature access (TFA) telephony employs a TFA or "glass phone" device also coupled to the local area network, but which receives its call processing through the TFA controller on the PBX. *That is, in such a system, both ToL telephones and glass phones are coupled to a same local area network but receive call processing from independent entities, i.e., the ToL gatekeeper and the PBX.* A problem in such a system is that the ToL gatekeeper is not aware of TFA calls processed by the PBX and their bandwidth usage. Embodiments of the present invention, however, allow the TFA bandwidth usage by one of the call processing entities to be accounted-for by the other.

In contrast, neither Swartz nor Naudus have anything to do with such a system. Swartz provides a system that includes a LAN and a PBX. However, if anything, Swartz appears representative of the problem solved by the present invention: Even assuming that Swartz provides glass phones in its system, Swartz has nothing to do with call processing on a LAN by a server and a PBX. Indeed, as acknowledged in the Official Action, Swartz does not "teach the server configured to provide call processing, to monitor bandwidth usage of calls it processed, including means for accounting for bandwidth requirements of telephony devices coupled to the gateway for which the server has not performed call processing...". Because Swartz does not relate to a PBX and a server (or other LAN entity) both providing call processing for devices coupled to the LAN, it is clear that Swartz does not even recognize the problem solved by the present invention. 5

Moreover, none of these features, and certainly not the invention as a whole, are taught, suggested, or implied by Naudus. Naudus relates merely to a system for providing DTMF tones in an Internet telephony system. From this, the Official Action concludes that it would have been obvious to "provide the server configured to provide call processing, to monitor bandwidth usage of calls it

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processed including means for accounting for bandwidth requirements of telephony devices coupled to the gateway...". However, like Swartz, Naudus does not relate to a PBX and a server (or other LAN entity) both providing call processing for devices coupled to the LAN. Thus, even in combination, the references do not teach, suggest, or imply a system in accordance with the present invention.

Furthermore, Applicants respectfully submit that since neither Swartz nor Naudus even recognize the problem solved by the present invention, it appears to Applicants that their own disclosure is being used as the sole motivation to combine these disparate references. Applicants note that the Court of Appeals for the Federal Circuit has warned against "the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher." *W.L. Gore & Assoc. v. Garlock, Inc.*, 220 U.S.P.Q. 303 (Fed. Cir. 1983). Indeed, "[d]etermination of obviousness cannot be based on the hindsight combination of components selectively culled from the prior art to fit the parameters of the patented invention." *ATD Corp. v. Lydall, Inc.*, 48 U.S.P.Q.2d 1321 (Fed. Cir. 1998). Instead, "[t]here must be a teaching or suggestion within the prior art, or within the general knowledge of a person of ordinary skill in the field of the invention, to look to particular sources of information, to select particular elements, and to combine them in the way they were combined by the inventor." *Id.* Because the problem solved by the present invention is not even recognized in the prior art, Applicants respectfully submit that there can be no motivation to combine such references. As such, the Examiner is respectfully requested to reconsider and withdraw the rejection of the claims.

Claims 6-13, 15-16, and 18 have been rejected under 35 U.S.C. § 103 as being unpatentable over Swartz in view of Naudus, and further in view of Medhat et al., U.S. Patent No. 6,314,103 ("Medhat"). Applicants respectfully submit that the claimed invention is not taught, suggested, or implied by Swartz, Naudus, or Medhat, either singly or in combination. Swartz and Naudus have been discussed above. Medhat is relied on for allegedly teaching bandwidth allocation. However, like Swartz and Naudus, Medhat has nothing whatsoever to do with the invention of

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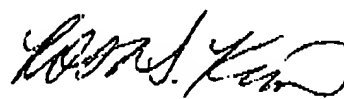
the underlying claims. As such, its combination with them cannot render obvious the invention of these dependent claims. As such, the Examiner is respectfully requested to reconsider and withdraw the rejection of the claims.

For all of the above reasons, Applicant respectfully submits that the application is in condition for allowance, which allowance is earnestly solicited.

Respectfully requested,

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MARKED UP CLAIMS

1. (Thrice Amended) A telecommunications system, comprising:
 - a private branch exchange (PBX) coupled to a local area network (LAN), said PBX including a telephony feature access (TFA) gateway [(TFA)];
 - a server coupled to said local area network, said server configured to provide call processing via said LAN and configured to monitor bandwidth usage of calls it has processed on said LAN;
 - one or more telephony devices operably coupled to said TFA gateway for call processing;
 - one or more second telephony devices operably coupled to said server for call processing; and
 - means associated with said server for accounting for bandwidth requirements of said one or more telephony devices operably coupled to said TFA gateway on said LAN and for calls for which said server has not performed said call processing.
5. (Twice Amended) The telecommunications system according to claim 2, wherein said one or more second telephony devices coupled to said server for call processing are able to communicate with said H.323 server.
14. (Twice Amended) A system for processing telephone calls, comprising:
 - a private branch exchange (PBX) coupled to a local area network (LAN), said PBX having associated therewith a telephony feature access (TFA) gateway, said PBX and TFA gateway adapted to provide call processing for TFA telephones on said LAN;
 - a telephony over LAN (ToL) gatekeeper coupled to said LAN and configured to provide call control services for ToL phone calls on said LAN; and
 - means associated with said ToL gatekeeper for monitoring bandwidth usage of telephone calls for which said ToL [gatekeeper] ~~gatekeeper~~ has not provided call control services and processed via said TFA gateway.

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16. (Amended) The system according to claim 14, said monitoring means including means for aborting at least one of said [a] ToL phone calls [call] if said bandwidth is not available.